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| EXAMINER |
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TALBOT, MICHAEL

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| ART UNIT | PAPER NUMBER |
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3722

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/579,480 | Applicant(s) AEBERHARD ET AL. | |
| | Examiner MICHAEL W. TALBOT | Art Unit 3722 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/16/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the (1) “disassembly screw having a “dd” with a male thread capable of being braced on the spindle head” recited in claim 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The abstract of the disclosure is objected to because of (1) “the use of legal phraseology” and (2) “refers to purported merits or speculative applications of the invention. Correction is required. See MPEP § 608.01(b).

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3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Comment [M1]: You should use form paragraph 6-16 instead of 6-14 (or in addition to 6-14) since applicant has provided the language "connecting means."

5. The disclosure is objected to because of the following informalities:

Refer to page 4, line 24, the character reference "screw head g 19" should be changed so as to read --threaded bore 19--.

Refer to page 4, lines 27 through 28, the character reference "male thread 22" should be changed so as to read --male thread 23--.

Refer to page 5, line 15, the character reference "corner edges 191" should be changed so as to read --corner edges 181--.

Refer to page 5, line 25, the character reference "screw 22" should be changed so as to read --screw 20--.

Refer to page 5, line 33, the character reference "spindle head 181" should be changed so as to read --spindle head 131--.

Refer to page 6, line 14, the character reference "screw 22" should be changed so as to read --screw 20--.

Appropriate correction is required.

Claim Objections

6. Claims 1-3 and 7-9 are objected to because of the following informalities:

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Claim 1 recites the limitation “the wall” in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation “the adjacent outer portion” in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation “the free end” in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 3, line 2, character reference “the outer portion 162” should be changed so as to read --the outer portion (152)--, or better yet delete all character reference numbers from the recited claims.

Claim 7, line 2, character reference “a regular hexagonal prism (16)” should be changed so as to read --a regular hexagonal prism (18)--, or better yet delete all character reference numbers from the recited claims.

Claim 8 recites the limitation “the free face end” in lines 2 through 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation “the outside diameter” in line 5. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "a hand-held power tool", and the claim also recites "in particular a power drill or screwdriver" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Mack (US 5,988,958). Mack '958 shows in Figures 1 and 3 a hand-held power tool (1) having a chuck (2), a spindle (16,17,19) which drive the chuck and protrudes with a spindle head (17) into a recess (15,18) of the chuck, and a connection means (15,21) for connecting the drive spindle and the chuck in a manner fixed against rotation, wherein the connection means have axially extending cutting edges (tooth of 21) embodied on the chuck spindle head that cut into a wall of the recess

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when the chuck is being slipped onto the spindle head (col. 3, lines 4-26). Mack '958 further shows the recess embodied with a stepped diameter having an inner portion (15) with an inside diameter that is smaller than that of an adjacent outer portion (18), wherein the cutting edges are located on a portion of the spindle head (at 27) that is set back from a free end of the spindle head (end/tip of 17) and on the free end of the spindle head a guide portion (17) precedes the portion (at 27) of the spindle head is embodied. Mack '958 further shows an outside diameter of the guide portion is adapted to the inside diameter of the inner portion of the recess. Mack '958 further shows the inside diameter of the outer portion of the recess in the chuck is smaller than the outside diameter of the cutting edges, so that the cutting edges on the spindle head can cut into the chuck (col. 3, lines 20-26). Mack '958 further shows the spindle head with the cutting edges is hardened, or is of harder material than the chuck (resulting from tooth ring 21 biting into the chuck body as taught in col. 3, lines 20-26). Mack '958 further shows the recess and spindle head are embodied cylindrically, and the cutting edges are formed by a notched toothing encircling the spindle head.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mack (US 5,988,958). Mack '958 does not disclose expressly that "at least in the region of the portion of the spindle head that has the cutting edges formed therein, the shape is one of a polygonal prism or a regular hexagonal prism". Instead, Mack '958 indicates "at least in the region of the portion of the spindle head that has the cutting edges formed therein, the shape is one of a

tooth ring 21". At the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to select "at least in the region of the portion of the spindle head that has the cutting edges formed therein, the shape is one of a polygonal prism or a regular hexagonal prism" because Applicant has not disclosed that the "at least in the region of the portion of the spindle head that has the cutting edges formed therein, the shape is one of a polygonal prism or a regular hexagonal prism" provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the "hand-held power tool" of Mack '958, and Applicant's the "hand-held power tool" to perform equally well with either the indicates "at least in the region of the portion of the spindle head that has the cutting edges formed therein, the shape is one of a tooth ring 21" as taught by Mack '958 or the claimed "at least in the region of the portion of the spindle head that has the cutting edges formed therein, the shape is one of a polygonal prism or a regular hexagonal prism" because both "toothed constructions" would provide the desired mechanical coupling of the harder teeth into the softer chuck body.

Furthermore, Applicant does not provide any criticality or unexpected results for the "at least in the region of the portion of the spindle head that has the cutting edges formed therein, the shape is one of a polygonal prism or a regular hexagonal prism" as recited in claims 6 and 7.

13. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mack (US 5,988,958) in view of March (US 2,874,985). Mack '958 lacks the spindle head having a coaxial threaded bore terminating in a free face end into which a securing screw is threadingly coupled to axially brace the chuck, the securing screw comprises a screw head and a male threaded screw shank, the chuck further comprises a stepped bore having a smaller diameter, female-threaded portion terminating into the chuck recess, and the screw can be braced on the spindle

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head via a chamfer face surrounding the threaded bore opening or on the bottom of the threaded bore embodied as a blind bore.

March '985 shows in Figure 1 a hand-held power tool (10) having a chuck (12), a spindle (11) which drive the chuck and protrudes with a spindle head (11g) into a recess (10c) of the chuck, and a connection means (11h and col. 2, lines 40-45) for connecting the drive spindle and the chuck in a manner fixed against rotation. March '985 further shows the spindle head having a coaxial threaded bore (11j) terminating in a free face end into which a securing screw (22) is threadingly coupled to axially brace the chuck, the securing screw comprises a screw head (Fig. 1) and a male threaded screw shank (Fig. 1), the chuck further comprises a stepped bore (Fig. 1) having a smaller diameter, female-threaded portion terminating into the chuck recess, and the screw can be braced on the spindle head via a chamfer face (Fig. 1) surrounding the threaded bore opening or on the bottom of the threaded bore embodied as a blind bore (Fig. 1). In view of this teaching of March '985, it would have been obvious to one of ordinary skill in the art to modify the hand-held power tool of Mack '958 to include a securing screw as taught by March '985 to provide for a releasable securing means to securely draw the chuck onto the spindle (col. 2, lines 58-67).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning the content of this communication from the examiner should be directed to Michael W. Talbot, whose telephone number is 571-272-4481. The examiner's office hours are typically 8:30am until 5:00pm, Monday through Friday. The examiner's supervisor, Mrs. Monica S. Carter, may be reached at 571-272-4475.

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In order to reduce pendency and avoid potential delays, group 3720 is encouraging FAXing of responses to Office Actions directly into the Group at FAX number 571-273-8300. This practice may be used for filling papers not requiring a fee. It may also be used for filing papers, which require a fee, by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Michael W. Talbot of Art Unit 3722 at the top of your cover sheet.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. W. T./
Examiner, Art Unit 3722
11 March 2008

/Monica S. Carter/
Supervisory Patent Examiner, Art Unit 3722